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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,351	10/21/2003	Seth A. Foerster	OP-11-1	4188
21394 7590 11/17/2009 ARTHROCARE CORPORATION ATTN: Matthew Scheele 7500 Rialto Boulevard Building Two, Suite 100 Austin, TX 78735-8532				
EXAMINER NGUYEN, VIX				
ART UNIT 3731		PAPER NUMBER		
NOTIFICATION DATE 11/17/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel\_prop@arthrocure.com

# Office Action Summary

## Application No.

10/690,351

## Applicant(s)

FOERSTER ET AL.

## Examiner

Victor X. Nguyen

## Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 5/12/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action is in response to the RCE filed on 5/12/2009.

Claims 1-9, 11-12 and 24-31 are pending in this present application.

***Claim Objections***

2. Claim 30 is objected to because of the following informalities: Claim 30, line 1 "in claim 30" should be "in claim 26". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor et al 5,935,107.

Claim 26: Taylor et al disclose a first configuration and second configuration, said first configuration (fig. 6) characterized by a body (a body is made up of combination of item 10 and 30) having a longitudinal axis, a proximal end, and a distal end, which is adapted to be inserted into a bone, said body having an outer peripheral wall extending substantially completely about said longitudinal axis and defining an inner lumen, said body including a plurality of spaced slits 56 disposed about said outer peripheral wall, each of said slits extending axially and defining ribs 52-58 therebetween, each of said ribs comprising a fixed proximal end, an intermediate section, and a fixed distal end, and said second configuration (fig. 9) characterized by the intermediate section expanding radially outward such that said apparatus has a larger cross- section in said

second configuration (fig. 9) than in said first configuration (fig. 6) wherein said apparatus further comprises a laterally disposed suture hole (the suture hole occurs at the area of item 61) for receiving a suture.

Claims 27-28: Taylor et al disclose wherein each of said slits further comprises an angled surface at an end thereof, and wherein each of said angled surfaces extending depth wise into a wall forming said body (fig. 10).

Claims 29-31: Taylor et al disclose wherein said plurality of spaced slits each lie at an acute angel relative to said longitudinal axis, wherein said acute angle is between 0 and 45 degrees (see fig. 2); and wherein said ribs 52-58 are operable to expand radially and extend into adjacent bone upon said body being placed in compression (see col. 2, lines 59-67).

Claims 1-9, 11, 12, 24-31 are rejected under 35 U.S.C. 102 (e) as being clearly anticipated by Tran et al 6,582, 453.

Claims 1-9, 11, 12, 24-31: Tran et al clearly disclose the invention substantially as claimed (see figures 3, 4, 7, 8).

Claims 1-9, 11, 12, 24-31 are rejected under 35 U.S.C. 102 (e) as being clearly anticipated by Foerster et al 6,660,008.

Claims 1-9, 11, 12, 24-31: Foerster et al clearly disclose the invention substantially as claimed (see figures 3, 4, 7, 8, 11, 12).

Claims 1-8, 11, 12 and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Ritchart et al 6,524,317.

Claim 1: Ritchart et al disclose apparatus for attaching connective tissue to bone, comprising a first configuration and second configuration, said first configuration characterized by a body 627 having a longitudinal axis, a proximal end, and a distal end, which is adapted to be inserted into a bone, said body having an outer peripheral wall extending substantially completely about said longitudinal axis and defining an inner lumen, said body including a plurality of spaced slits 59 or 629 disposed about said outer peripheral wall, each of said slits having a length, wherein a distance x (the distance x occurs to the right side of item 629) between two adjacent slits at a first location along the length of each of the slits is smaller than a distance y (the distance y consists of the areas between items 629, 630, 637) between said two adjacent slits at a second location along the length of each of the slits; each of said slits extending substantially axially and defining ribs there-between, each of said ribs comprising a fixed proximal end, an intermediate section and a fixed distal end and said second configuration characterized by portion the intermediate section of said outer peripheral wall being radially enlarged relative to said longitudinal axis such that said apparatus has a larger cross-section in said second configuration (fig. 17) than in said first configuration (fig. 19) at said portion.

Claims 2-4: Ritchart et al disclose the slits 59 or 629 which each comprises an end, said first location being proximate to an end of each of the adjacent slits and the second location being in a middle region of each of the adjacent slits, wherein each of said slits further comprises an angled surface at an end thereof, wherein each of said slits further comprises an angled surface at each end thereof, each of said angled surfaces extending depth wise (it is noted that slits 59 have angled surfaces that extend depth wise, fig. 19) into a wall forming said body.

Claims 5-6: Ritchart et al disclose the body comprises a generally cylindrical body, and said peripheral wall comprises an outer circumferential wall, and wherein said plurality of spaced slits are generally parallel to said longitudinal axis (fig. 17).

Claims 7-8 and 24: Ritchart et al disclose the plurality of spaced slits each lie at an acute angle relative to said longitudinal axis and wherein said acute angle is between 0 and 45 degrees, wherein when said body is placed in compression, regions of said outer wall between adjacent ones of said spaced slits expand radially to extend into adjacent bone (fig. 19).

Claims 11-12: Ritchart et al disclose apparatus for attaching connective tissue to bone, said bone having a bone surface, comprising a body 627 having a longitudinal axis, a proximal end, and a distal end, which is adapted to be inserted into a bone such that the proximal end remains within said bone and below the bone surface, said body having an outer peripheral wall extending substantially completely about said longitudinal axis and defining an inner lumen, said body including a plurality of spaced slits 629 extending substantially axially and longitudinally disposed about said outer peripheral wall, each of said slits having a length and an angled surface at an end thereof, extending depth wise into a wall forming said body and each slit defining ribs 673 there between, each of said ribs comprising a fixed proximal end, an intermediate section, and a fixed distal end.

Claim 25: Ritchart et al disclose a suture retaining feature such that a suture 39 may be connected with said apparatus to connect tissue to said bone.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richart et al.

Claim 9: Richart et al disclose the limitation of claim 1 with the spaced slits comprise at least three slits (fig. 19) except for the spaced slits comprise at least six slits disposed about the circumference of the outer peripheral wall. However, it is well known to have at least six slits disposed about the circumference of the outer peripheral wall in order to secure the device from being inadvertently backed out of the hole and further to increase the reliability of the invention device so that the Ritchart device would too have this advantage.

#### ***Response to Arguments***

4. Applicant's arguments filed on 5/12/2009 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AnhTuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor X Nguyen/

Examiner, Art Unit 3731

/(Jackie) Tan-Uyen T. Ho/

Supervisory Patent Examiner, Art Unit 3773